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JUN 01 2000

**SPECIAL PROGRAMS OFFICE
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In re Patent No. 5,084,004
Issue Date: January 28, 1992
Application No. 07/449,942
Filed: December 29, 1989
Inventor: Claud Ranoux

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: DECISION ON PETITION
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This is a decision on the petition under 37 CFR 1.378(b), filed February 18, 2000, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is DISMISSED.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$130 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued January 28, 1992. The first maintenance fee due could have been paid during the period January 28, 1995 through July 28, 1995, or with a surcharge during the period from July 28, 1996 through January 28, 1996. Accordingly, the patent expired January 28, 1996 for failure to timely submit the first maintenance fee.

The Commissioner may accept late payment of the maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. § 41(c)(1).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133

because 35 U.S.C. § 41(c)(1) uses the identical language, i.e., "unavoidable" delay. Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for scheduling payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 608-609, 34 USPQ2d at 1787. While Cushman and Toshiba both assert the belief that the other was the responsible party, such will not be permitted to excuse both Cushman and Toshiba from the obligation of each to exercise the due care of a reasonably prudent person. Assuming, *arguendo*, that Cushman may have erred in assuming that Toshiba would pay the maintenance fee, such error(s) is, nevertheless, chargeable to Toshiba. The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the patent holder, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, petitioners' delay caused by mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, *id*; Smith v. Diamond, *id*; Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, *id*; Douglas v. Manbeck, *Id.*. Consequently, the delay caused by the failure of Cushman to timely remit the maintenance fee, by Toshiba's asserted understanding (and Cushman's asserted misunderstanding) of the supposed agreement, does not constitute

unavoidable delay. Ray, Id. Moreover, as noted *supra*, that delay is chargeable to Toshiba. Assuming, *arguendo*, that Cushman was correct in assuming that Toshiba bore the responsibility for paying the maintenance fee, the record shows that Toshiba failed to exercise due diligence, after becoming aware of the impending issuance of this patent, to determine its issue date, and thus, in time, the date to submit the maintenance fee, or to allocate that responsibility. Moreover, the showing of record is that neither Toshiba or Cushman had timely reached an adequate understanding in this matter, which is not grounds for a finding of unavoidable delay in submission of the maintenance fee, within the meaning of 35 USC 41(c) and 37 CFR 1.378(b).

Petitioner asserts that the delay in payment of the maintenance fee came about as a result of unusual circumstances occurring upon the transfer of responsibility for payment of the maintenance fee from petitioner Young & Thompson to the French law firm of Cabinet Bonnet-Thirion (hereinafter "CBT"). Petitioner asserts that both Young & Thompson and CBT had reliable computerized docketing and tracking systems to ensure timely payment of the maintenance fee, but that due to the filing of a reissue application shortly after the patent issued, data pertaining to this patent was not entered into CBT's system upon their assumption of responsibility to ensure payment of the fees. Petitioner additionally asserts that error on the part of the examiner by not determining that the patent had expired during examination of the reissue application and the long delay in examination of the reissue application both contributed to the delay in payment of the maintenance fee, preventing delayed payment under the unintentional standard within the two year period specified in 37 CFR § 1.378(c).

Petitioner Young & Thompson is additionally patentee's counsel of record with respect to this patent. As petitioner's representative, Young & Thompson, upon receipt of the letters patent, was aware of the need to diligently schedule and pay the maintenance fee. Petitioner asserts that the computerized docketing and tracking system utilized by Young & Thompson was a reasonably prudent and reliable system. However, the petition does not present any details of the system upon which an evaluation of this assertion can be based. Any renewal of this petition must provide a factual showing of the adequacy and reliability of this system, such as by way of affidavit from one knowledgeable of the system.

Assuming, *arguendo*, that the system of Young & Thompson was a reliably prudent means to ensure payment of maintenance fees, the existence of such a system does not, *per se*, establish unavoidable delay with respect to this patent. No showing has

been submitted to establish that the instant patent was actually entered into this system. In fact, the petition does not even make a specific assertion as to this matter. Petitioner simply states that a reliable system was in place.

Petitioner asserts that their responsibility to ensure payment of the maintenance fee for this patent terminated on February 5, 1994, being assumed at that time by CBT. However, no evidence has been submitted to substantiate assumption of responsibility by CBT with respect to this patent. Exhibit C does not identify this patent by number or identifier.

Exhibit C additionally includes the following statement:

"Paris February 5, 1984

We confirm you are to discontinue docketing your cases. The fee address indication form is to be made out under the name of Accumas Computer Packages Annuity Services, payee number....."

The source of this statement is not identified in Exhibit C. It is merely a cut-and-paste from some unidentified source. Additionally, this statement speaks to discontinuing docketing of cases, and does not speak to the tracking of cases already docketed. Any renewed petition with regard to this matter must submit a documentary showing if reliance is to be placed on CBT as the responsible party for payment of maintenance fees with respect to this patent. Also, the record is not clear how both Young & Thompson and CBT separately and together ensured that all patents that were under Young & Thompson's control were satisfactorily transferred to the control of Accumas Computer Packages Annuity Services, and why that control system failed to indicate this patent was not transferred to Accumas. Further, the record is not clear why CBT assumed that Accumas was tracking this patent.

Assuming, *arguendo*, that CBT had been properly appointed to conduct petitioner's patent matters subsequent to February 5, 1994, including matters pertaining to the payment of the maintenance fee, then any showing of unavoidable delay must establish the reasonable and prudent means employed by CBT to ensure payment of the fee. Petitioner merely presents a statement that CBT had such a system in place. Petitioner also asserts that CBT only enters patents into its system when they receive the letters patent grant. Assuming this to be the case, it would not seem prudent with respect to this patent, which CBT was fully aware was sent to petitioner and not CBT, for CBT to rely upon entry of this patent into its system based solely upon receipt of the original letters patent grant. Any renewed petition must present a documentary showing both of the system

used by CBT and their steps to ensure entry of this patent into their system.

Petitioner further states that, after transfer of responsibility for payment of the maintenance fee to CBT, Young & Thompson deleted records with respect to this patent from their system. No explanation is offered as to what steps, if any, were taken by Young & Thompson to ensure transfer of records with regard to this patent to CBT that would warrant deletion of this patent from their system.

Petitioner also contends that "(c)ontributing to the failure to pay maintenance fee with respect to this patent is the silence on this subject from the Examiner in charge of the reissue application." This assertion is not understood. The examiner had no way of knowing that maintenance fees had not been paid for the patent until after it expired. Thus, had the examiner determined at an earlier date that the patent had, in fact, expired, such a determination would have had no effect on failure of petitioner to pay the fee.

It is also asserted that earlier notice from the examiner may have enabled petitioner to file a petition within the two year period prescribed in 37 CFR § 1.378(c). While this may or may not be true, it has no bearing on the issue in this petition, which is unavoidable delay under section 1.378(b). However, it is noted that petitioner received a Reminder Notice from the PTO mailed September 5, 1995 (prior to expiration of the patent on January 28, 1996) and Notice of Expiration mailed 1/28/96. As patentee's designated counsel, it was the responsibility of counsel to pursue timely petition to accept delayed payment of the maintenance fee. That counsel did not pursue this matter within the two year period prescribed in section 1.378(c) is responsibility of counsel, not the PTO.

It is the responsibility of patentee or his designee to pay maintenance fees. Under the statute and rules, the Office has no duty to notify patentee of the need to pay maintenance fees or to notify patentee that maintenance fees are due. While the Office mails maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid. Failure to receive the Reminder does not relieve the patentee of the obligation to timely pay the maintenance fee, nor will it constitute unavoidable delay if the patentee seeks reinstatement under the regulation. The lack of knowledge of the patentee to pay maintenance fees does not constitute unavoidable delay. See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd, Rydeen v. Quigg, 748 F.Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623

(Fed. Cir. 1991).

For the above stated reasons, the delay in payment of the maintenance fee in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41 and 37 CFR 1.378(b).

Petitioner is advised that if the petition is not renewed, or if renewed and not granted, the fees paid to date are refundable. A copy of this decision and a written request for refund should be addressed to the Office of Finance, Refunds, at the PTO address.

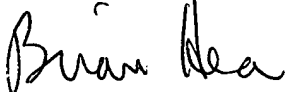
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision should be directed to Robert Garrett at (703) 308-0763, or in his absence, the undersigned at (703) 305-1820.



Brian Hearn
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for Patent Examination Policy